

Application Serial No. 10/775,574  
Amendment dated August 14, 2006  
Reply to Office Action mailed February 14, 2006

### **REMARKS**

Claims 1-11 and 13-16 are pending. Claims 1, 2, 4, 5, 8, 9 and 11 have been amended herein. New Claims 13-16 have been added. As set forth more fully below, reconsideration and withdrawal of the Examiner's rejections of the claims are respectfully requested.

#### **Information Disclosure Statement:**

The Examiner has requested a new copy of the Finnin reference submitted with the Information Disclosure Statement mailed June 17, 2005. A copy of the Finnin is re-submitted with this Response for the Examiner's review.

#### **Rejections Under 35 U.S.C. § 112, First Paragraph**

The Examiner has rejected Claims 2-11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner argues that recitation of extracts of miura puama, catuaba and maca encompass "potentially millions of types of extracts" which could be obtained from these plant sources and, therefore, the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicants have amended the pending claims to specify that the extracts are alcohol extracts of the medicinal plants. Support for this amendment can be found at least at paragraphs [0020]-[0022] of the instant specification, as published. Applicants submit that this disclosure describes the preparation of alcohol extractions of these medicinal plant materials used in the preparation of the instantly-claimed compositions and Claims 2-11, as amended, recite plant extracts that were clearly contemplated and in possession of the inventors at the time of filing.

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In view of the foregoing remarks and claim amendments, applicants submit that there is adequate enablement in the specification for Claims 2-11, as amended, and request the Examiner's rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

#### Claim Rejections Under 35 U.S.C. § 102

The Examiner has rejected Claim 1 under 35 U.S.C. § 102(b) as being anticipated by page 1 of the Alternative Medicine Network Women's Health site (hereinafter "AMN site"). The Examiner states that the AMN site discloses a cream containing L-arginine and methyl nicotinate for topical application.

Applicants have amended Claim 1 to require a composition containing methyl salicylate in addition to L-arginine and methyl nicotinate. Support for this amendment can be found at paragraph [0027] of the instant specification, as published. Applicants submit that the AMN site does not describe or suggest a topical composition containing methyl salicylate, L-arginine and methyl nicotinate and, therefore, Claim 1, as amended is not anticipated by the AMN site. Applicants therefore respectfully request the Examiner's rejection under 35 U.S.C. § 102(b) be withdrawn.

#### Claim Rejections Under 35 U.S.C. § 103

The Examiner has rejected Claims 1-11 under 35 U.S.C. § 103(a) as being obvious over

- 1) the AMN site referenced above,
- 2) U.S. Patent Publication No. 2003-0077296 (**Denton et al.**)
- 3) U.S. Patent No. 6,340,480 (**Duckett et al.**)

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- 4) U.S. Patent Publication No. 2002-0817165 (**Harbeck**)
- 5) English abstract of German Patent No. 4007975 (**Neumayr**)
- 6) An advertisement for the Passion Booster product from the Las Vegas Review
- 7) U.S. Patent No. 5,208,031 (**Kelly**), and
- 8) U.S. Patent No. 6,803,060 (**Reyes**).

The Examiner argues that each of these references teach one of the ingredients of the claimed topical compositions except for nettle and zinc. With respect to nettle, the Examiner states that nettle is known for treating libido. With respect to zinc, the Examiner states that the addition of zinc to topical lubricants is conventionally used to prevent herpes. Thus, the Examiner argues that it would have been obvious to select a single ingredient from each of these references with nettle and zinc, modifying the concentration of each, to form a topical composition as claimed in the instant application.

Initially, Applicants note that these references do not teach the addition of methyl salicylate, methol or the deposition of these ingredients on a condom as required by Claims 1, 2, and 7, respectively. Therefore, these claims are not *prima facie* obvious as the list of references cited does not teach all of the limitations of these claims.

Applicants further submit that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hospital Systems v. Montofiore Hospital, 221 USPQ 929, 933 (Fed.Cir. 1974). The Examiner's position is that the individual ingredients of the currently-claimed compositions could have been selected from amongst the many ingredients of the cited

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references to successfully form a topical composition having the desired therapeutic effects.

Applicants respectfully disagree with this assertion.

There is no stated motivation or suggestion to make the combination of ingredients in any of the eight references cited by the Examiner. That is, there is no motivation to combine a single ingredient from each of these references to form the claimed compositions other than Applicants' specification. It is well established, however, that an evaluation of the obviousness or non-obviousness of claims must not be made with the benefit of hindsight using the Applicants' application as a blueprint to reconstruct the claimed invention from the references. See Interconnect Planning Corporation v. Feil, 227 USPQ 543 (Fed.Cir. 1985). Yet without any motivation or suggestion in the cited art to combine the individual ingredients disclosed in eight separate references with nettle and zinc, it is clear that the Examiner searched the prior art for disclosures of the individual ingredients the same, or similar to, the individual compounds or extracts within the topical compositions of the present invention using the instant specification as a guide. The Examiner then argues that it would have been obvious to combine these separate ingredients without any motivation or suggestion. This is the impermissible hindsight analysis referred to in Interconnect Planning that does not render the instantly claimed compositions obvious.

Thus, Applicants submit that there is no teaching or suggestion in the prior art to motivate one of skill in the art to combine a single ingredient from each of the AMN site, Denton et al., Duckett et al., Harbeck, Neumayr, the Las Vegas Review advertisement, Kelly and Reyes with nettle and zinc to form the compositions of the present invention and request that the

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Examiner's rejection under 35 U.S.C. § 103(a) based on this combination of references be withdrawn.

Based upon the foregoing, Applicants believe that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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